



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

MJ

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,913	11/07/2000	J. P. Leon	00696-02500US	2660
20350	7590	03/18/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			COSIMANO, EDWARD R	
		ART UNIT	PAPER NUMBER	
		3629		

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/708,913	LEON, J. P.	
	Examiner	Art Unit	MW
	Edward R. Cosimano	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 December 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-65 is/are pending in the application.
 - 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-65 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11/7/00 & 12/22/03 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. A substitute specification including the claims is required pursuant to 37 CFR § 1.125(a) because the number of amendments contained in the amendment filed December 29, 2003.
 - 2.1 A substitute specification filed under 37 CFR § 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR § 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR § 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.
3. The following objections, note sections 4-7 below, would be withdrawn once the amendments of December 29, 2003 have been properly entered in the substitute specification required above.
4. The use of various trademark(s) for example: Yahoo®, Macintosh® PC's, Apple Computer, Inc., Intel®, Netscape Navigator®, Internet Explorer®, Microsoft Corporation, Windows®, Java®, have been noted in various paragraphs on pages 6, 7, 8 & 11.
 - 4.1 Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.
5. The drawings are objected to because
 - A) the following errors have been noted in the drawings:

(1) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

(a) 704 & 706 as disclosed in:

(a)(1) the paragraphs between page 17, line 1, and page 20, line 17, , "Fig. 7 depicts ... servers 704 (with associated cryptographic modules 706) ... server 704 via an ODBC interface."; and

(a)(2) the paragraphs between page 23, line 23, and page 27, line 19, "If it determined ... data structure may include:".

(2) the drawings lack fig. 10 as disclosed in the paragraph bridging pages 25-26, "PSMD server 704 ... explained below with respect to Fig. 10.".

5.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

6. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the application data on page(s) 1-2, 11, 13, 14 & 15, with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

B) as required by 37 CFR § 1.84(p)(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) 200, 204, 206, 213 & 214 of fig. 2 as disclosed in the paragraphs between page 8, line 29, and page 14, line 27, "Referring to Figs. 2 and 3, ... scope of the claims which set forth the invention.";

(b) 232-1, 232-2, 704-1, 704-2, 706-1 & 706-2 of fig. 7 as disclosed in the paragraphs :

(b)(1) between page 17, line 1, and page 20, line 17, , "Fig. 7 depicts ... servers 704 (with associated cryptographic modules 706) ... server 704 via an ODBC interface."; and

(b)(2) between page 23, line 23, and page 27, line 19, "If it determined ... data structure may include."; and

(c) 812 of fig. 8 in the paragraph at page 23, lines 23-30, "If it is determined ... the work among PSMD servers 704.".

In this regard, it is noted that merely mentioning a number without mentioning the device or operation of the step relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

C) the following errors have been noted in the specification:

(1) as can be seen in fig. 7 and from the context of the disclosure:

(a) between page 17, line 1, and page 20, line 17, , "Fig. 7 depicts ... servers 704 (with associated cryptographic modules 706) ... server 704 via an ODBC interface."; and

(b) between page 23, line 23, and page 27, line 19, "If it determined ... data structure may include.";

each reference to reference number:

(a) "232" should be --232-1--, and --232-2--.

(b) "704" should be --704-1--, and --704-2--.

(c) "706" should be --706-1--, and --706-2--.

Appropriate correction is required.

7. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

8. In regard to the following rejections based on the prior art:

A) it is respectfully noted that the function provided by hyper text is to either:

(1) transfer the user from one point on a network to another point on the network; or

(2) to retrieve additional information from the network;

which one of ordinary skill at the time the invention was made would have recognized a functionally equivalent to a function call or a request from one system to an other system.

B) it is respectfully noted that the function provided by web is a communications network between one point on a network to another point on the network, , where a server controls access to a point in the network, one of ordinary skill at the time the invention was made would have recognized that the restricted access to postage metering functions of the prior art as functionally equivalent to the claimed server, note the definition of a "server" found on page 355 of "Microsoft Press® Computer Dictionary" Second edition, 1994, Microsoft Press A Division of Microsoft Corp. One Microsoft Way Redmond, Washington 98052-6399, (discussed during the interview of November 13, 2003).

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9.1 Claims 1-29, 31-39, 40-63 & 65 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Shah et al (5,822,738).

9.1.1 In regard to claims 1-3, 8-15, 20-26, 28, 32-36, 38, 42-49, 51, 52, 54, 56-58, 60-63 & 65, Shah et al ('738) discloses that an user at system (20,430,480(1),480(N): figs. 6,7) after obtaining all of the necessary information for a postage indicia formulates a request for postage and sends the request via a communications link to proxy computer (120,410: figs. 6,7). Proxy computer, which can not dispense postage, passes the request for postage to SMD (210,400: figs. 6,7). SMD (210,400), which is licensed to dispense postage by an associated carrier, for example the United States Postal Service (USPS), once the request has been validated creates a completer postage indicia based on the request. Next SMD (210,400) sends the postage indicia back through the proxy computer (120,410) to the user's system (20,430,480(1),480(N)). Finally the user may print the postage indicia on an item of mail.

9.1.2 In regard to claims 4, 16, 31 & 41, since the postage dispensing system of Shah et al ('738) is implemented using a number of computers which require an operating program to control the operation of the system, the system of Shah et al ('738) inherently contains a number of software components.

9.1.3 In regard to claims 5, 6, 17 & 18, since the postage dispensing system of Shah et al ('738) is implemented using a number of computers which will automatically print the postage indicia, the system of Shah et al ('738) inherently prints the indicia with or without human intervention.

9.1.4 In regard to claims 7, 19, 27, 37, 53 & 59, since the postage dispensing system of Shah et al ('738) is implemented using a number of computers that use standard printers and not a photographic reproduction process, the system of Shah et al ('738) inherently contains a bit-

map of the indicia in order to properly control the standard printer to accurately reproduce the indicia.

9.1.5 In regard to claims 9, 10, 29, 39, 50 & 55, since the postage dispensing system of Shah et al ('738) uses an indicia that is combination of fixed or background information and variable information, e.g. the date, postage, and verification data, the system of Shah et al ('738) inherently combines these two sources of information to complete the postage indicia.

9.2 Claims 1-29, 31-39, 40-63 & 65 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Carroll et al (6,470,327) or Bator et al (6,619,544).

9.2.1 In regard to claims 1-3, 8-15, 20-26, 28, 32-36, 38, 42-49, 51, 52, 54, 56-58, 60-63 & 65, either Carroll et al ('327) or Bator et al ('544) disclose that an user at a client system, after obtaining all of the necessary information for a postage indicia, formulates a request for postage and sends the request via a communications link to a postage metering system/server. Postage metering system includes a SMD, which is licensed to dispense postage by an associated carrier, for example the United States Postal Service (USPS), once the request has been validated creates a completer postage indicia based on the request. Next the SMD sends the postage indicia back through the postage metering system to the user's system. Finally the user may print the postage indicia on an item of mail.

9.2.2 In regard to claims 4, 16, 31 & 41, since the postage dispensing systems of either Carroll et al ('327) or Bator et al ('544) are implemented using a number of computers which require an operating program to control the operation of the system, the systems of either Carroll et al ('327) or Bator et al ('544) inherently contains a number of software components.

9.2.3 In regard to claims 5, 6, 17 & 18, since the postage dispensing systems of either Carroll et al ('327) or Bator et al ('544) are implemented using a number of computers which will automatically print the postage indicia, the systems of either Carroll et al ('327) or Bator et al ('544) inherently prints the indicia with or without human intervention.

9.2.4 In regard to claims 7, 19, 27, 37, 53 & 59, since the postage dispensing system of either Carroll et al ('327) or Bator et al ('544) are implemented using a number of computers that use standard printers and not a photographic reproduction process, the systems of either

Carroll et al ('327) or Bator et al ('544) inherently contains a bit-map of the indicia in order to properly control the standard printer to accurately reproduce the indicia.

9.2.5 In regard to claims 9, 10, 29, 39, 50 & 55, since the postage dispensing systems of either Carroll et al ('327) or Bator et al ('544) uses an indicia that is combination of fixed or background information and variable information, e.g. the date, postage, and verification data, the systems of either Carroll et al ('327) or Bator et al ('544) inherently combines these two sources of information to complete the postage indicia.

10. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

10.1 Claims 30, 40 & 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Shah et al (5,822,738) or Carroll et al (6,470,327) or Bator et al (6,619,544) as applied above to claims 1-29, 31-39, 40-63 & 65 in view of an inherent necessity.

10.1.1 In regard to claims 30, 40 & 64, either Shah et al ('738) or either Carroll et al ('327) or Bator et al ('544) does not disclose using the XML communications protocol, however, Shah et al ('738) does disclose the use of a protocol which will support the required communications between the various components of the system, therefore it would have been obvious to one of ordinary skill at the time the invention was made that the systems of either Shah et al ('738) or either Carroll et al ('327) or Bator et al ('544) could be modified to use any suitable

communications protocol that would support the communications requirements of the systems of either Shah et al ('738) or either Carroll et al ('327) or Bator et al ('544) in order to accomplish the proper operation of the systems of either Shah et al ('738) or either Carroll et al ('327) or Bator et al ('544).

11. Response to applicant's arguments.

11.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

11.2 As per the 35 U.S.C. § 102 & 35 U.S.C. § 103 rejections, merely calling an item something with out attributing specific functions to it that would clearly distinguish it from any other device that would be recognized as performing the same function does not provide functional descriptive material on which a patentable distinction may be based. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Hence, applicant's arguments are non persuasive.

12. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

- 13.1 The fax phone number for **UNOFFICIAL/DRAFT FAXES** is (703) 746-7240.
- 13.2 The fax phone number for **OFFICIAL FAXES** is (703) 872-9306.
- 13.3 The fax phone number for **AFTER FINAL FAXES** is (703) 872-9306.

03/11/04

Edward Cosimano
Edward R. Cosimano
Primary Examiner A.U. 3629